

REMARKS

Applicant has not amended any claims. Claims 72-78, 82-84, and 104-108 are pending in this application.

The only rejections in this application are provisional and actual obviousness-type double patenting rejections. These rejections fall into two categories: 1) those relying upon the claims of co-filed applications [Paper No. 28 at pp. 2-6], and 2) those relying upon the claims of later-filed, improvement applications (or the resulting patents) [Paper No. 28 at pp. 7-27]. Regarding the first category, applicant intends to file terminal disclaimers to remove the rejections over the co-filed applications (Application Nos. 08/460,902 and 08/461,292). Because these are provisional rejections, however, applicant need not address them at this time.

The remaining rejections rely upon the claims pending in or issued from applications that applicant filed several years after applicant originally filed the present specification on May 1, 1987 (as Application Serial No. 07/044,719). Specifically, the Examiner provisionally rejected or actually rejected various combinations of claims 91-97, 99, 101-103, 106-108, and 129-133 under the judicially created doctrine of obviousness-type double patenting over claims 135-148 of Application No. 09/549,200, claims 65-68 of Application No. 09/549,697, claims 1-21 of U.S. Patent No. 6,303,379 (Application No. 08/354,883), claims 1-11 of U.S. Patent No. 6,048,729 (Application No. 334,797), claims 1-18 of U.S. Patent No. 6,054,288 (Application No. 443,936), claims 1-10 of U.S. Patent No. 5,994,127 (Application No. 334,455), claims 1-9 of U.S. Patent

No. 6,048,524 (Application No. 446,909), claims 1-3 and 13-16 of U.S. Patent No. 6,187,305 (Application No. 446,921), and claims 1-16 of U.S. Patent No. 6,355,241 (Application No. 420,861). [Paper No. 28 at pp. 7-27.]

Applicant traverses these rejections. Before addressing the merits of these rejections, however, Applicant will first address their improper reintroduction **over two and one-half years** after the PTO withdrew these same rejections.

A. The Office Action improperly makes rejections that the PTO withdrew over two and one-half years previously

Applicant first addressed the obviousness-type double patenting rejections over the later-filed applications in an interview with the previous Examiner. The Examiner agreed that the claims pending in the later-filed, improvement applications were nonobvious over the claims in the present application. Thus, the previous Examiner stated, "It appears that certain of the double-patenting rejections will fall in light of 2-way obviousness." [Paper No. 24.] Exhibit A to that Interview Summary indicates that those "certain" double-patenting rejections were the double patenting rejections over the later-filed, improvement applications, with the Examiner writing "2-way 'secondary'" next to a list of the cited applications that were filed in 1991 and 1992 but not the list of the co-filed applications. [Examiner Interview Summary Record of February 7, 2000, Exhibit A.]

In the next Office Action, the previous Examiner again stated that, "if 2-way obviousness must be applied . . . then the rejections should be withdrawn." [Paper No.

24 at p. 8 (original emphasis).] Only because the previous Examiner was not certain that a two-way obviousness test was required did she maintain the rejections. [*Id.*]

In a subsequent interview, applicant's representative showed the previous Examiner that two-way obviousness was required to maintain the rejections. The Examiner agreed that applicant's arguments "appear to support a two-way test." [Examiner Interview Summary Record of April 27, 2000.] The previous Examiner also indicated that, if a two-way obviousness test were applied, and only the provisional rejections over the co-filed applications remained, "it appears suspension of the application may be appropriate." [*Id.*]

In the subsequent Amendment, applicant repeated the arguments made during the interview. The Examiner responded by withdrawing the obviousness-type double patenting rejections over the claims of the later-filed applications and suspending prosecution of the application on August 3, 2000. [Paper No. 26.] Prosecution remained suspended for over two and one-half years until the PTO mailed the present Office Action on February 11, 2003.

The MPEP commands that "full faith and credit should be given to the search and action of the previous Examiner unless there is a clear error in the previous action . . ." M.P.E.P. § 704.01. Applicant respectfully submits that the Office Action does not give "full faith and credit" to these actions of the previous Examiner. Giving full faith and credit to the actions of the previous Examiner requires accepting the determinations of the previous Examiner and not revisiting them. The Office Action

does not accept the determinations of the previous Examiner. Instead, it makes the opposite determinations, reinstating rejections the previous Examiner expressly withdrew.

The double patenting rejections over the later-filed applications were the focus of two interviews, an amendment, and two Office Actions. Through this prosecution, applicant and the previous Examiner were able to resolve all issues other than those being considered in the interference. At that point, prosecution was suspended pending termination of the interference, when those remaining issues could be considered.

Failing to give "full faith and credit" to the actions of the previous Examiner is especially improper here. Section 704.01 of the MPEP indicates that it is designed "to avoid piecemeal prosecution." *Id.* Prosecution of the present application was suspended for two and one-half years because the previous Examiner withdrew the double patenting rejections over the later-filed applications. Upon the resumption of prosecution, the Office Action reintroduced those very rejections. Thus, applicant has been placed in the same position as he was before prosecution was suspended because full faith and credit has not been accorded, as the MPEP commands, to the determinations of the previous Examiner. Such an arbitrary creation of piecemeal prosecution is not proper.

Such an arbitrary creation of piecemeal prosecution is especially improper in an application that has been suspended by the PTO. Piecemeal prosecution is to be avoided because it needlessly increases application pendency. This specification has already been pending since **1987**. During this time, applicant has diligently prosecuted this specification. Upon resolution of all but the interference issues, the PTO suspended prosecution for two and one-half years. Once the interference issues were resolved, however, the Examiner did not allow the present application. Rather, the Examiner reinstated the previously overcome double patenting rejections, prolonging the pendency of this specification even further.

Reintroducing a previously withdrawn rejection in an application whose prosecution was suspended pending termination of an interference is particularly prejudicial where the reintroduced rejection is an obviousness-type double patenting rejection. Such a rejection can be removed by filing a terminal disclaimer. If an Examiner maintains the obviousness-type double patenting rejection, rather than suspending prosecution, the applicant could continue prosecution and, perhaps, decide to file a terminal disclaimer. Upon termination of the interference, a patent would issue for the undisclaimed portion of the issuing patent's term. By prolonging the pendency of such an application, however, the PTO deprives the applicant of patent term. The terminal disclaimer sets the term of the issuing patent to expire at a certain date. The later the patent issues, the less undisclaimed term it has left.

Applicant's prosecution of the later-filed applications has also been prejudiced by the reinstatement of the previously-withdrawn rejections. When the previous Examiner withdrew the obviousness-type double patenting rejections over the later-filed applications, the majority of the cited applications and patents had not yet issued as patents. While prosecution was suspended in this application, Applicant was forced to act in the later-filed applications. Applicant took those actions relying upon the previous Examiner's withdrawal of the obviousness-type double patenting rejection over the later-filed applications.

If uncorrected, the PTO's reinstatement of the previously withdrawn obviousness-type double-patenting rejections over the claims of the later-filed, improvement applications would result in exactly the result the MPEP strives to avoid. To avoid needlessly increasing application pendency through piecemeal prosecution, an application that raises issues that are being considered in an interference involving a related application "should be carried as far as possible." § 2315.01. For this reason, the MPEP requires that potential interference issues in the application not in interference be addressed by making provisional rejections over the count of the interference. The remaining issues are to be prosecuted "as far as possible."

The MPEP indicates that "as far as possible" means until all other rejections are overcome:

& 23.17 *Rejection Based on Count of an Interference*

The rejection of claim [1] above based on count [2] of Interference No. [3], to which applicant is a party, is a provisional rejection for the purpose of resolving all remaining issues in this application. The provisional assumption that the count is prior art under 35 U.S.C. ' 102(g) against this application may or may not be true, and the **prosecution in this case will be suspended** pending final determination of priority in the interference if and **when no other issues remain**.

§ 2315.01 at p. 2300-27, col. 2 (emphasis added). In other words, an application will be suspended only when all issues other than those related to the interference have been overcome. Once the issues related to the interference are resolved, therefore, no other issues will remain, and the application should be allowed.

The PTO followed this procedure until the present Office Action. After all issues other than those related to the interference were resolved, the Notice of Suspension stated:

The rejection of claims 91-99, 101-103, 106-108, and 129-131 above based on count of Interference No. 103,708, to which applicant is a party, is a provisional rejection for the purpose of resolving all remaining issues in this application. The provisional assumption that the count is prior art under 35 U.S.C. ' 102(g) against this application may or may not be true, and the **prosecution in this case will be suspended** pending final determination of priority in the interference if and **when no other issues remain**.

The outcome of Interference No. 103,708 has a material bearing on the patentability of the claims in this application. Prosecution in this application is SUSPENDED pending a final judgment in the interference.

Applicant should call this case up for action upon termination of the interference.

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[Paper No. 26 (bold emphasis added.) Thus, the PTO told applicant that it was suspending prosecution of the application because only issues related to the interference remained. All other issues, including the presently reinstated obviousness-type double patenting rejections over the later-filed applications, had been overcome. Upon resolution of the issues related to the interference, therefore, no other issues remained, and the application should have issued. Instead, the Office Action reinstated the previously withdrawn double patenting rejections over the claim of the later-filed applications.

The only possible justification for the PTO's reinstatement of the previously withdrawn obviousness-type double patenting rejections over the later-filed applications would be if the PTO believed the previous Examiner committed "a clear error in the previous action[s]." § 704.04 at p. 700-6, col. 2. The Office Action, however, does not address any of the previous prosecution on this issue—not the previous Examiner's withdrawal of these rejections and not applicant's previous arguments, which resulted in that withdrawal. If the PTO maintains these rejections because the previous Examiner made "a clear error," applicant respectfully requests that the PTO so indicate, together with reasoning in support of the change in the PTO's position. See M.P.E.P. § 706.04 (repeating same "full faith and credit" paragraph as § 704.01 and stating, "Because it is unusual to reject a previously allowed claim, the examiner should point out in his or her office action that the claim now being rejected was previously allowed by using Form Paragraph 7.50."). This will allow applicant to decide on the proper forum for seeking

review of the PTO's reintroduction of the previously withdrawn rejections. See *Ex parte Natta*, Appeal No. 95-2683 (Bd. Pat. App. & Intf., July 29, 1998) (stating that a rejection that may violate M.P.E.P. § 706.04 "may be a petitionable matter to the Commissioner").

B. The obviousness-type double patenting rejections over the later-filed applications should be withdrawn, again

As the previous Examiner found, the rejections over the claims of the later-filed applications require a two-way obviousness test and, as the previous Examiner also found, application of such a test indicates that those rejections should be withdrawn. When an applicant could not have filed the claims at issue and the claims cited against them in a single application, and there is administrative delay, a double patenting requires a finding of two-way obviousness. M.P.E.P. § 804 at p. 800-23, col. 2. Two-way obviousness requires **both** that the claims at issue are obvious over the cited claims **and** that the cited claims are obvious over the claims at issue. *Id.* "If **either** analysis does not compel a conclusion of obviousness, no double patenting rejection of the obvious-type is made" *Id.* (emphasis added.) Here, the claims at issue originated from an application filed on May 1, 1987, while the cited claims originated in an improvement application filed on November 5, 1991. These two applications—original and improvement—differ substantially from each other, and they were filed over four and one-half years apart. Accordingly, there is no doubt that the claims could not have been filed in a single application.

The issue then becomes whether there is administrative delay, specifically whether the administrative process is primarily responsible for a delay resulting in the present earlier-filed application issuing after the later-filed, improvement applications. M.P.E.P. § 804 II.B.1(b) at p. 800-24, col. 1. The MPEP specifically identifies a delay due to the resolution of issues in an interference as a delay that is primarily due to the administrative process. *Id.* “[T]he time spent in an interference proceeding can significantly delay the issuance of a patent.” *Id.*

The MPEP does provide one example of a case where a patent was found to be invalid for double patenting even though its issuance was delayed partially due to an interference. That case (*Pierce v. Allen B. DuMont Lab. Inc.*, 297 F.2d 323 (3d Cir. 1961)), however, is readily distinguishable from the present situation. As the MPEP recognizes, the applicant in *Pierce* made a “considered election to postpone acquisition of the broader [patent” *Id.* (quoting *Pierce*). Specifically, “*Pierce* could have obtained a comprehensive patent claiming and protecting his patent generically merely by paying a final [issue] fee on his approved [allowed] original application.” *Pierce*, 297 F.2d at 326. Instead, *Pierce* filed a continuation application. *Id.* (“a timely renewal of his application”). The court of appeals for the third circuit found the resulting generic patent to be invalid because “the inventor, by merely paying his final [issue] fee could have obtained his generic patent more than a year before he actually obtained the narrower patent” *Id.* at 329. Instead, he “made a considered election to postpone” issuance of the generic patent. *Id.*

Applicant made no such considered election to postpone issuance of the present claims. The claims in this application have—since the 1987 filing date—faced multiple rejections. They have never been allowed. Rather, applicant has actively sought to resolve all issues regarding the claims in the present application since 1987.

Prosecution of this application was suspended for three and one-half years, but that was done by the PTO and was compelled by the MPEP. Applicant could not have resolved the remaining issues because they were being considered in the interference.

Another important distinction exists between *Pierce* and the present case. In *Pierce*, the patents at issue were based on the same specification. Indeed, one was a divisional of the other. *Id.* at 326 (“[T]he still pending application contained all of the claims which were later to be divided and granted separately in patent ‘496 and patent ‘642.”). In contrast, the later-filed applications here are not divisionals of the original application. Rather, they issued from an application filed over four and one-half years later. Unlike the claims at issue in *Pierce*, the claims here could not have been filed in the same application, just as is required for the two-way obviousness test.

The only other case the MPEP cites where a court refused to apply a two-way obviousness test (*In re Emert*, 124 F.3d 1458 (Fed. Cir. 1997)) has similarly distinguishable facts. M.P.E.P. § 804 II.B. 1(b) at p.800-24, col. 1. As the MPEP discusses, in *Emert* the applicant had repeatedly extended periods for response to the maximum 6 months and then abandoned the application and filed a substantially identical continuation application. *Id.* The applicant's actions, not the PTO's, resulted

in no substantive response to the PTO's rejections for more than two years. The Federal Circuit called this the most important factor in deciding that the applicant, not primarily the PTO, was responsible for the delay in prosecution. *Emert*, 124 F.3d at 1461.

Again, these facts are readily distinguishable from the present situation. Applicant has not repeatedly engaged in the delaying refiling of *Emert*. Thus, the delay was the very type of delay the MPEP contemplates as being primarily due to "an interference proceeding"—a delay that is primarily due to the administrative process. M.P.E.P. § 804 II.B.1(b) at p. 800-24, col. 1.

Applicant has been even less responsible for the delay in issuance of claims from this application than the applicants were in a case the MPEP cites as an example of a two-way test being applied because the PTO was **primarily** responsible for the delay. The MPEP states that in *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 23 U.S.P.Q.2d 1839 (Fed. Cir. 1992) (copy attached), the Federal Circuit "did not hold the patentee accountable for a delay in issuing the first filed application until after the second filed application issued as a patent, **even where the patentee had intentionally refiled the first filed application as a continuation-in-part after receiving a Notice of Allowance**" *Id.* at col. 2 (emphasis added). Applicant never received a Notice of Allowance for this specification, and Applicant never refiled this specification as a continuation-in-part application.

For all these reasons, a two-way obviousness test should be applied, as the previous Examiner recognized. As the previous Examiner also recognized, Application of a two-way test will result in withdrawal of these rejections over the claims in the later-filed applications. The later-filed, improvement claims, which all specifically recite primary or secondary cells, are nonobvious over the present, original, claims, which all recite, simply, cells. The Examiner found that the claims pending in the later-filed applications were nonobvious over the claims in the present application for this reason. [Examiner Interview Summary Record of February 7, 2000, Exhibit A.] The previous Examiner withdrew the obviousness-type double patenting rejections over the claims of the later-filed applications for this reason. [Paper No. 26.] Application of a two-way obviousness test reveals that, just as the previous Examiner did, the PTO should again withdraw the obviousness-type double patenting rejections over the claims of the later-filed applications.

In view of the foregoing amendments and remarks, applicant respectfully requests the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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